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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Richard G. Hartmann

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IBM CORPORATION - DEPT. 917  
3605 HIGHWAY 52 NORTH  
ROCHESTER, MN 55901-7829

EXAMINER

REILLY, SEAN M

ART UNIT

PAPER NUMBER

2153

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/932,615	HARTMANN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sean Reilly	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-106 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-106 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Office action is in response to Applicant's amendment and request for reconsideration filed on November 7, 2006. Claims 1-106 are presented for further examination. All independent claims have been amended.

#### ***Specification***

Applicant's amendments to the specification as filed on April 20, 2006 were previously accepted however upon further consideration the amendments to paragraph 24 line 16 constitute new matter because the new scope of a computer program product or a program element, or a program storage or memory device is not supported by the original disclosure.

Accordingly the amendment filed April 20, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. Applicant is required to cancel the new matter in the reply to this Office Action.

#### ***Response to Arguments***

In response to Applicant's request for reconsideration filed on September 18, 2006 and November 17, 2006 the following factual arguments are noted.

- a. Applicant's amendments to the claims overcome the outstanding 35 U.S.C. 101 rejection.
- b. The combination of Chen and Boe is improper and fails to disclose the claimed direct negotiation session communication between the client and server.

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In considering (a), Examiner respectfully disagrees with Applicant's argument.

Applicant has amended the claims to include the term *tangible*. The term *tangible*, as used by Applicant in claims 105 and 106, is not given patentable weight since artisans in the art reasonably disagree as to the scope of the term in the context of computer readable mediums. Some artisans in the art define signals as a tangible medium while others do not.

In view of the above objection regarding amendments to the specification as filed on April 20, 2006, Applicant's specification paragraph 24 line 16 provides evidence that Applicant intends the scope of a computer readable storage medium to include a solid or fluid transmission medium hence, each claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore these claims are not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and thus is not a machine or manufacture. Energy is not a physical article or object and thus is not a composition of matter. Applicant may overcome this 101 rejection by limiting the scope of a computer readable storage medium such that solid and fluid transmission mediums are excluded.

In considering (b), Examiner respectfully disagrees with Applicant's argument. Foremost Applicant should note that Chen clearly shows that the client and server are involved in direct telnet negotiations over a single protocol (TCP/IP) (see inter alia Figure 1). Applicant has successfully amended to overcome the Boe 102 rejection as indicated in the previous final rejection on July 17, 2006. However, in the current 103 rejection Examiner proposes modifying the telnet negotiation of Chen to include the negotiations of Boe utilized between the TN3270

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server and host mainframe 12. Examiner does not purpose bodily incorporating Boe's legacy communication architecture. Rather Examiner proposes modifying the particular negotiations utilized between the TN3270 server and host mainframe 12. Thus, in the combined system the client and server will perform telnet negotiations over a direct connection, as is performed in the current Chen system (see inter alia Figure 1), with the added negotiation parameters from Boe.

Examiner also maintains that there is clear motivation for such a combination. In particular, one of ordinary skill in the art would have been motivated to incorporate the telnet negotiation parameters disclosed by Boe within Chen's system in order to further expand the compatibility of Chen's system, by enabling telnet clients to communicate with telnet servers/mainframes that utilize the old proprietary SNA server protocol and thus increase the number of telnet servers a client can communicate with. Furthermore one of ordinary skill in the art would have naturally incorporated known telnet negotiation schemes that are known to be reliable in newer telnet systems (such as Chen's system), in order to design reliable telnet systems by using known communication schemes. Such a design principle is analogous to the philosophy, "don't reinvent the wheel."

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**2. Claims 71-106 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

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3. With regard to claims 105 and 106, Applicant's specification paragraph 24 line 16 of provides evidence that Applicant intends the scope of a computer readable storage medium to include a solid or fluid transmission medium hence, each claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore these claims are not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and thus is not a machine or manufacture. Energy is not a physical article or object and thus is not a composition of matter. Applicant may overcome this 101 rejection by limiting the scope of a computer readable storage medium such that solid and fluid transmission mediums are excluded. Applicant is invited to review the latest "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (signed October 26<sup>th</sup>, 2005) which further clarifies computer-related nonstatutory subject matter on pages 50-57.

[http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf)

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**2. Claims 1-106 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant failed to disclose the use of a *legacy host* in any of the disclosed**

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embodiments. Furthermore Applicant failed to even mention the term legacy host anywhere in the specification. Applicant points to the specification pg 4, line 1 – pg 5, line 17, as providing support for this added limitation (see Applicant response September 18, 2006, pg 38 last ¶) however along with the rest of the specification a legacy host is not disclosed. Thus, Applicant failed to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claims 1-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boe et al. (U.S. Patent Number 6,122,276; hereinafter Boe) and Chen et al. (U.S. Patent Number 6,182,220; hereinafter Chen) and Murphy et al. (RFC 287, “5250 Telnet Enhancements” July 2000; hereinafter Murphy).**

5. With regard to claim 1, Chen disclosed a method for processing a client (telnet client, figure 1) session request received at a server in a system including a client and a server with both server and client executing exit programs for negotiating a confirmation record on a session connection request in which direct communication between said client and said server is held for duration of a dialogue (see inter alia figure 1, showing the direct negotiation communication between the client and server), comprising the steps: negotiating environment parameters for establishing a

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connection-oriented connection of said server with said client (e.g. telnet client and server negotiating environment options, see inter alia Col 2, lines 54-65), said client and said server communicating over said connection using a same client/server communications protocol (e.g. TCP/IP, see Figure 1); said client including a graphical user interface (required for a user to login and control a telnet session, see inter alia Col 1, lines 25-30); said server inviting said client to submit user variables (Col 2, lines 55-58).

Chen disclosed substantial features of the claimed invention however, Chen failed to specifically recite: 1) said client including a graphical user interface selectively assigned a session name enabling client emulator communication at an application layer with said server, 2) responsive to receiving a user variable requesting a custom confirmation record received at said server from said client, said server sending to said client a confirmation record and custom record data for enabling said client to engage in subsequent programmable negotiations directly with said server, and 3) a legacy host in the system.

With regard to point 1), Chen failed to specifically recite said client including a graphical user interface selectively assigned a session name enabling client emulator communication at an application layer with said server. Nonetheless it was widely known in the art at the time of Applicant's invention to assign session names to telnet session, as evidenced by at least Murphy. In a similar telnet system Murphy disclosed assigning a session name (i.e. virtual device name, see inter alia virtual device negotiations pg 6 and device name collision processing pg 14). The utilizing a virtual device name during a telnet session the server is able to identify all the parameters negotiated and allocated to a particular virtual device (Murphy pg 6). Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to



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incorporate the virtual device name functionality as disclosed by Murphy within Chen's system, so that Chen's telnet server is able to identify all the parameters negotiated and allocated to a particular virtual device for a client's telnet session.

With regard to point 2) Chen disclosed substantial features of the claimed invention however, Chen failed to specifically recite responsive to receiving a user variable requesting a custom confirmation record received at said server from said client, said server sending to said client a confirmation record and custom record data for enabling said client to engage in subsequent programmable negotiations directly with said server. Nonetheless such a telnet negotiation scheme was widely known and utilized in the networking art at the time of Applicant's invention, as evidenced by Boe. In an analogous telnet system, Boe disclosed negotiating environment parameters for establishing a telnet session between a client (TN3270 server) and a server (Host Mainframe 12) (see inter alia, figure 4). Boe further disclosed responsive to receiving a user variable requesting a custom confirmation record received at said server from said client, said server sending to said client a confirmation record (line D, fig. 4); host sends a confirmation response to requesting client via the server to signify a connection and custom record data for enabling said client to engage in subsequent programmable negotiations directly with said server (line E, fig. 4, col. 5, lines 25-28., in response to the client request, host sends custom record data (local address x) to client, thus forming a custom confirmation record). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to incorporate the telnet negotiation scheme disclosed by Boe within Chen's system, in order to further expand the compatibility of Chen's system, by enabling telnet clients to communicate with telnet servers that utilize the old proprietary SNA server protocol or protocols derived from

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the old proprietary SNA server protocol. Additionally Boe's negotiation scheme allows additional telnet capabilities to be negotiated and implemented and would thus increase the telnet capabilities and features of Chen's system.

With regard to point 3), Chen failed to disclose a legacy host in the system. Nonetheless, Boe disclosed using a legacy host system to enable telnet users to communicate with legacy systems that do not support new communication protocols (Boe Col 1, lines 18-33). Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to incorporate Boe's legacy host system in Chen's telnet system in order to enable telnet users to communicate with legacy systems that do not support new communication protocols.

6. Claim 18 is rejected for similar reasons as claim 1 addressed above. Boe further teaches client (18, fig. 1)/server (20, fig. 1) system; a user exit program running on said server (abstract); said client operating in conjunction with said user exit program for requesting said custom confirmation record (lines A and B, fig. 4).

7. With regard to claims 2, 33, 59, 64, 72, 89, Chen disclosed negotiating, inviting, and sending steps executing within the application layer of a TCP/IP protocol stack (Chen Figure 1, TCP/IP is the protocol used for communication).

8. As per claim 3, Boe teaches the step responsive to a user variable requesting a confirmation record, sending to said client a confirmation record without said custom record data (Fig. 4, line E).

9. With regard to claims 4-6, Boe further teaches the confirmation record including a field defining a pass through data length, said pass through data including said confirmation record

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and said custom record data (RU, fig. 2, col. 4, lines 38-40, lines 64-66; col. 5, lines 7-10, lines 25-28; RU (Request/Response Unit) field includes subfields that indicate various data parameters of the request/response/packet); appending said custom record data to said confirmation record (line E, fig. 4; in addition to default response stated in claims 2-3 above, updated responses also includes custom record data x).

10. With regard to claims 7-8, Boe further teaches the request being for a defined custom confirmation record, said request including a list of one or more predefined information items (local address x), further comprising the step of sending to said client defined data in said custom record data (line E, fig. 4).

11. As per claims 9-12 and 17, Boe teaches providing in said custom record data indicia identifying a device, terminal, associated device (line C, fig. 4., device model=ml) allocated by a host server; physical location (line C, fig. 4., local address=x) for receiving output; and custom information for interpretation by said client (col. 5, lines 25-29; host sends custom response record to client.)

12. As per claims 13-16, Boe teaches the client negotiating with the host to establish a connection (line B, fig. 4). Boe further teaches plurality of new clients trying to log on and negotiating with the host for service connection (lines M, N, fig. 4). However, Boe does not specifically disclose providing in custom record data indicia identifying system security level and password encryption requirements, another device for retrying a rejected request, a reason for a failed auto-signon request, and a reason for denial of session connection request upon system overload and redirection to an alternate time or host. Nonetheless providing such

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information to clients logging into telnet system was widely known at the time of the invention, as evidenced by Murphy. In an analogous art, Murphy disclosed a standard for telnet clients and servers to communicate (Abstract). Murphy's protocol provides clients logging into a telnet system with detailed custom record data response codes for use in establishing and debugging connections (Murphy see inter alia pgs 20 and 21 Response codes). The response information includes identifying system security level and password encryption requirements (Murphy see pgs 7 and 8), another device for retrying a rejected request, a reason for a failed auto-signon request, and a reason for denial of session connection request upon system overload and redirection to an alternate time or host (see inter alia pgs 20 and 21 Response codes). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Murphy into Boe's system in order to maintain compatibility with other known telnet protocols and further to provide connecting clients with more detailed connection information for negotiating and debugging telnet sessions.

13. As per claim 19, Boe teaches client being a Telnet client (e.g. the TN3270 Server receives telnet session information from the Host mainframe Figure 4, lines D or E).

14. Claims 20 and 22 are rejected for similar reasons as claims 1-8 and 18 addressed above.

15. Claims 21, 44-47, 83-86, 100-103 are rejected for similar reasons as claims 13-16 addressed above.

16. Claims 23, 32, 49, 58, 63, 71, 88, 105, and 106 are rejected for similar reasons as claim 1 addressed above. Boe further teaches negotiating environment parameters for establishing a connection-oriented connection with said server (lines B, C, fig. 4; environment parameters include PSIO, Power on, LocAdd-x, etc.)

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17. Claims 34, 60, 65, 73, 90 are rejected for similar reasons as claims 3 above.

18. Claims 35-37, 61-62, 66-68, 74-76, 91-93 are rejected for similar reasons as claims 4-6 above.

19. Claims 38-39, 69-70, 77-78, 94-95 are rejected for similar reasons as claims 7-8 above.

20. Claims 40-43, 48, 79-82, 87, 96-99, and 104 are rejected for similar reasons as claims 9-12 and 17 above.

### *Conclusion*

21. The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure.

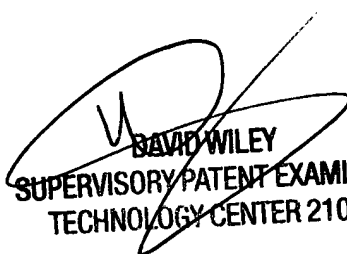
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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January 17, 2007

  
DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100